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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/502,812	02/09/2000	Bert D. Cook JR.	ULT-001-1P	5712
22888	7590	09/15/2004	EXAMINER	
BEVER HOFFMAN & HARMS, LLP TRI-VALLEY OFFICE 1432 CONCANNON BLVD., BLDG. G LIVERMORE, CA 94550			WALSH, DANIEL I	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 09/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/502,812

Applicant(s)

COOK ET AL.

Examiner

Daniel I Walsh

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 20 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-40 and 66-76 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18, 23-40 and 66-74 is/are rejected.
- 7) ☒ Claim(s) 19-22, 75 and 76 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1-04 and 5-04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Receipt is acknowledged of the IDS received on 20 January 2004 and 24 May 2004 and the Amendment received on 20 January 2004.

#### ***Claim Objections***

2. Claim 10 is objected to because of the following informalities:

Re claim 10, line 4: Replace "f or" with -- for --.

Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-2, 6-18, 23-40, and 66-74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Godfrey (US 5,288,942).

Re claim 1, Godfrey teaches a portable card comprising a substrate having a predetermined shape; and an accessible embedded storage member having at least one layer of storage material for storing information enclosed by the substrate, the storage member and the substrate being adapted to be transported relative to each other to expose at least a portion of the storage member to facilitate processing of stored information and for embedment of the storage member with the substrate (FIG. 3, abstract, and col 1, lines 5+). The Examiner has interpreted the claim in light of FIG. 58A of the current application where a substrate of a card is taught as a housing, and storage member 958 is interpreted by the Examiner as the memory contents/card. Re claim 2, Godfrey teaches an elongated strip member (col 1, lines 13+), as magnetic stripes are well known and conventional in the art. Re claim 6, it is obvious that the card can be removed for exposing it to a processing station/reading device, and that the card and reader are moved relative to each other (see below for details). Re claim 7, magnetic mediums have been discussed above (re claim 2). Re claims 8-9, the Examiner notes that optical/magneto-optical cards are well known and conventional in the art, and placing them in a device such as that taught by Godfrey is well within the skill in the art, to hold/organize/transport such cards. Re claim 10, the Examiner notes it's well known and conventional in the art to have high-density high coercivity magnetic material for cards (see US 5,009,925). Re claim 11, the Examiner notes that magnetic strips are conventionally coated with a protective layer, and that such a layer can be interpreted as abradable (wearable), (further see US 6,310,471, 3,838,252, and 4,783,374). Re claims 12-14, the Examiner notes that it is well known and conventional in the

art for magnetic cards to be moved relative to a reader, for a reader to be moved relative to a card, and that readers and cards are moved relative to each other for reading (see US 5689105, 4812632, and 5107099 for examples). Re claim 15, the limitations have been discussed above re claim 1, where it is obvious that the card is to be read by a processing station/reader. Re claims 16-18, the limitations have been discussed above, re claims 10 and 11. Re claim 18, it is well known and conventional that magnetic stripes are made of thin films, and that they have a predetermined magnetic field that permits reading/writing of data (see US 6,482,330 for example). Re claim 23, the limitations have been discussed above re claim 4. Re claims 24-28, the Examiner notes that rectangular shaped storage (magnetic strips), circular storage (magnetic arc/circles), two-three removable and reinsertable embedded storage members (credit cards with a plurality of magnetic strips), are all well known cards in the art, able to be held by a device taught by Godfrey, to transport cards. Re claims 29-30, the Examiner notes it's well known and conventional in the art to read a card with a transducer, and that inductive read heads are commonly used to read magnetic cards. Re claims 30-33, the Examiner notes that such read heads are well known and conventional in the art for reading magnetic data. If the Applicant disagrees, and suggests that such readers are patentably distinct within the invention, a restriction may be enforced. Re claims 34-36, the Examiner notes that depending on the orientation of the card and the processing station, the magnetic field orientation of the material can take a parallel, perpendicular, or acute orientation with respect to the processing station. Re claims 37-40, the Examiner notes that such means for applying a magnetic material (coating) are well known and conventional. If the Applicant disagrees and suggest that such sputtering means are patentably distinct within the invention, a restriction may be enforced. Further, the

Examiner notes that simply adjusting the orientation of a station or a card, is an obvious matter of design variation, as such orientation does not serve a particular purpose that is not taught by what is conventional in the art (i.e. reading and writing to magnetic mediums). Re claims 66-69, the limitations have been discussed above, re claims 1, 10, and 11. Re claims 70-72, the Examiner notes that it is well known for magnetic materials to be isotropic, and anisotropic (see US 4,650,597, and US 6,467,691). Platinum is an isotropic material, and therefore its selection is obvious to provide predictable results. Re claim 73, the limitations have been discussed above, re claim 1. The Examiner notes that it is well known and conventional for card information to be processed by a transducer. Re claim 74, the limitations have been discussed re claim 10.

4. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Godfrey, as applied to claim 1 above, further in view of Liu et al. (US 2001/0052543).

The teachings of Godfrey have been discussed above.

Godfrey is silent to circular storage members.

Liu et al. teaches circular storage members (magnetic) (FIG. 2D-2Q).

At the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to combine the teachings of Godfrey with those of Liu et al.

One would have been motivated to do this in order to hold several cards, including those with data stripes, and arcs/circular storage.

5. Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Godfrey, as applied to claim 1 above, further in view of Middlemiss et al. (US 6,184,788).

The teachings of Godfrey have been discussed above.

Godfrey teaches a means for carrying cards, but is silent to the means/substrate having a first and second layer operatively coupled to each other so that the first layer is movable with respect to the second layer and wherein a storage member is located on at least one of the first or second layer.

Middlemiss et al. teaches such limitations (FIG. 3-FIG. 4) where a clamshell type cardholder is shown. Re claim 5, it is understood that opposite movement of opening (i.e. closing) embeds the storage member in the substrate.

At the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to combine the teachings of Godfrey with those of Middlemiss et al.

One would have been motivated to do this in order to have a substrate that holds storage members in a clamshell type arrangement, allowing easier access to the storage members/cards while providing more protection.

#### ***Allowable Subject Matter***

6. Claims 19-22 and 75-76 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record fails to teach a portable card with an accessible embedded storage member having at least one layer of storage material for storing information enclosed by the substrate, the storage member and the substrate adapted to be transported relative to each other to remove and expose at least a portion of the storage member to facilitate processing of stored

information by a data processing statement and for embedment of the storage member in the substrate where the storage member has at least one layer of high density high coercivity magnetic material for storing magnetic signals, an abradable protective coating formed on the magnetic layer where the protective coating has at least one layer which includes a magnetically permeable magnetically saturable material.

### ***Conclusion***

8. Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on 20 January 2004 and 24 May 2004 prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609(B)(2)(i). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Walsh whose telephone number is (571) 272-2409. The



examiner can normally be reached between the hours of 7:30am to 4:00pm Monday through Friday.

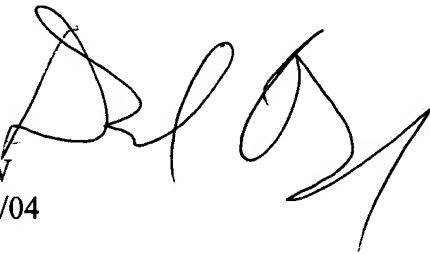
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone numbers for this Group is (703) 308-7722, (703) 308-7724, or (703) 308-7382.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [daniel.walsh@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

DW  
9/4/04



KARL D. FRECH  
PRIMARY EXAMINER